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09/785,700	02/16/2001	Robert M. Szabo	6169-156	4280
40987	7590	08/10/2009		
Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401			EXAMINER	
			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3688	
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			08/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/785,700

**Applicant(s)**

SZABO ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-9 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-9 and 25-29 have been examined. Application 09/785,700 (METHOD AND APPARATUS FOR STIMULATING COMMERCE) has a filing date 02/16/01.

### **Response to Amendment**

2. In response to Final Rejection filed 02/17/2009, the Applicant filed an RCE on 05/18/2009, which amended claims 1, and added new claims 25-29.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz (US 6,055,513).

As per claims 1, 25 and 29, Katz teaches:

A computer-implemented method of providing promotional material to consumers comprising:

detecting a business necessity in an inventory management system of a merchant computer system, the business necessity including the merchant receiving a shipment of goods (see col 23, lines 37-50);

*detecting products to be promoted based on the detected business necessity (see col 23, lines 40-50 "offer the product if the product would become available in a timely manner");*

establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system (see col 16, lines 20-32);

receiving in the third-party remote shopping stimulation system a merchant request from the merchant computer system to stimulate commerce for the detected products (see col 24, lines 30-50);

reading with said third-party remote shopping simulation system consumer purchase information from the merchant computer system, said consumer purchase information comprising consumer identifying information, purchased product information (see col 9, lines 20-45; col 10, lines 25-67) and communication mode information indicating in which communication mode promotional material can be delivered to a particular consumer (see col 11, lines 50-55);

wherein the purchased product information includes product expiration information and product identifying information (see col 27, lines 45-55);

based at least in part on said consumer purchase information, identifying one or more potential consumers who have previously purchased one or more of the detected products (see col 24, lines 30-50);

determining based upon predetermined product attributes irrespective of merchant inventories that at least one of the detected products is an obsolete product

when a new or alternate version of the at least one of the detected products has at least one among current availability and expected availability within a predetermined time period and ascertaining which of said identified potential consumers previously purchased at least one of said obsolete products (see col 24, lines 30-50);

in said third-party remote shopping stimulation system, generating promotional material for said new or alternate version of the at least one of the detected products of the one or more potential customers ascertained as having previously purchased the at least one of said detected product identified as an obsolete product, and associating said promotional material corresponding to said new or alternate version of the at least one of the merchant-specified products with said ascertained consumers (see col 24, lines 30-50)

determining for each of said identified consumers whether promotional material can be delivered via regular mail, electronic mail, telephone communication, or Internet communication, wherein the determination for each particular identified consumer is based upon communication mode information uniquely corresponding to the particular consumer (see col 11, lines 30-55);

making said promotional material available to said identified consumers using a promotional material delivery system (see col 11, lines 30-55)

wherein said delivery system delivers promotional material to each particular identified consumer via the communication mode indicated by the communication mode information uniquely corresponding to the particular consumer (see col 11, lines 30-55).

As per claim 2, Katz teaches:

said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of the least one merchant-specified product (see col 10, lines 57-65 “pattern or time basis to the customer’s purchasing”).

As per claim 3, Katz teaches:

wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see col 8, lines 32-50).

As per claim 5, Katz teaches:

wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see col 16, lines 22-32).

As per claim 6, Katz teaches:

wherein the one or more merchant-specified products comprise a service (see col 13, lines 25-35).

As per claim 7, Katz teaches:

said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is additionally based upon the expiration information of products (see col 24, lines 30-50; col 27, lines 45-50).

As per claim 8, Katz teaches:

wherein said promotional material made available to said identified consumers is in electronic format (see col 27, lines 15-20).

As per claim 9, Katz teaches:

wherein said promotional material made available to said identified consumers is in printed format (see col 19, line 65 – co 20, line 5).

Claim 26, Katz teaches:

a consumer purchase information data structure for storing consumer identifying information and product information corresponding to a purchase transaction (see col 9, lines 1-20).

Claim 27, Katz teaches:

a commerce system for collecting the consumer purchase information in a computer communications network environment (see col 9, lines 20-65).

Claim 28, Katz teaches:

a point of sale system for collecting the consumer purchase information from in store and Internet purchases (see col 9, lines 25-45).

#### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,055,513) in view of Barenbaum (US 2001/0039514).

As per claim 4, Katz teaches:

wherein each said step is performed responsive to the merchant system detecting a business necessity corresponding to said new or alternate versions of said product identified as an obsolete product, wherein said business necessity corresponds to a merchant of said new or alternate versions of said product identified as an obsolete product having inventory of said new or alternate versions of said product identified as an obsolete product (See col 23, lines 40-50; col 24, lines 30-50). Katz does not expressly mention that said inventory is excess inventory. However, Barenbaum teaches a system that detects over-stocked inventories and target offers to potential customers based upon said detection of over-stocked supply (see paragraph 18). Furthermore, Barenbaum teaches that said potential customers for said target offers are selected based upon said potential customers' previous purchases (see paragraph 35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would target offers to potential customers based upon detection of an over-stocked inventory, as taught by Barenbaum in order to better control an inventory size and avoid a clog up situation in a merchant's back-room storage.

#### **Response to Arguments**

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT A WEINHARDT can be reached on (571)272-6633. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
August 6, 2009